

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully requested.

Claims 1 – 17 are pending in the application and claims stand rejected. By the present amendment, new claim 18 has been added to the application.

In the office action mailed August 13, 2003, claims 1, 11, 14 and 15 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,121,880 to Scott et al.; claims 2 – 10, 12, 13, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al.; and claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document No. 58-135954 in view of Scott et al.

The foregoing rejections are traversed by the instant response.

The present invention relates to a compliant laminar eddy current sensitivity standard. The standard comprises a sheet of nonconductive, nonmagnetic material having a first planar surface and a second surface, at least one strand of a highly conductive material completely embedded in the sheet, and an adhesive layer affixed to the second surface of the nonconductive, nonmagnetic material. The adhesive layer contacts a part to be inspected.

Claims 1, 11, 14, and 15 are allowable because Scott et al. is not directed to a compliant laminar eddy current sensitivity standard. Scott et al. is directed to a transponder which has no utility whatsoever in inspecting parts. The Examiner dismisses the preamble as being a statement of intended use. The preamble is not a statement of use – rather, it identifies what the invention is and should be considered as a claim limitation. The preamble is to be accorded significance because it gives life, meaning, and vitality to the claims. It is well settled law that a preamble limits an invention of it is necessary to give life, meaning, and vitality to the claim. See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d, 1298, 1305, 51 USPQ2d 1161 (Fed. Cir. 1999). Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope. *Pitney Bowes* at 1306. Without question, the preamble of claims 1, 11, 14, and 15 is essential to understanding the limitations in the body of the claims. For these reasons alone, the Examiner should withdraw the rejection over Scott et al.

As for claim 15, Scott et al. clearly does not meet the limitations set forth in the claim since Scott does not inspect any part. Thus, it could not have a size and shape which corresponds to the size and shape of a part to be inspected.

As for claims 2 – 10, 12, 13, and 17, these claims are allowable because the Examiner has not made out a *prima facie* case of obviousness. The Examiner has not identified anything in Scott et al. or anything in the prior art which would teach, suggest or motivate one of ordinary skill in the art to modify Scott et al.'s transponder to have the claimed features.

As for the rejection of claim 16, the obviousness rejection fails because the Examiner offers no statement as to what would motivate one of ordinary skill in the art to modify Teruyoshi in the manner suggested in the rejection. Scott et al. is non-analogous art to Teruyoshi. The mere fact that particular claimed features can be found in the prior art is not sufficient to make an obviousness rejection. More is required – namely, some teaching, suggestion or motivation from the prior art. The Examiner has not identified any such teaching, suggestion or motivation.

New claim 18 is allowable for the reasons set forth herein and further because none of the cited and applied references teaches the claimed cooperating means.

For these reasons, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

Should the Examiner believe that an additional amendment is needed to place the case in condition for allowance, he is hereby invited to contact Applicants' attorney at the telephone number listed below.

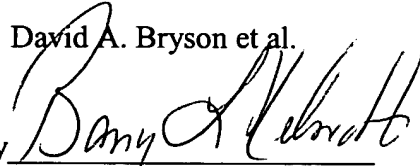
Appl. No. 09/917,979
Amdt. dated Nov. 12, 2003
Reply to office action of Aug. 13, 2003

The Commissioner is hereby authorized to charge said extra independent claim fee to Deposit Account No. 21-0279. Should the Commissioner determine that an additional fee is due, he is hereby authorized to charge said fee to said Deposit Account.

Respectfully submitted,

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By



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Date: November 12, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on November 12, 2003.



Nicole Motzer